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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,834	07/12/2001	Victor Chu	4123-004	9863

7590 12/16/2004
Adam M. Saltzman
Fish & Neave
1251 Avenue of the Americas
New York, NY 10020

EXAMINER

WORRELL JR, LARRY D

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,834

Applicant(s)

CHU, VICTOR

Examiner

Danny Worrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/2/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 18, 19 and 23-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18, 19 and 23-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15, 18, 19 and 22-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation “wherein the electronic display is not associated with the inherent function of the product” is indefinite since information about a product is “associated” with the function of the product. Also the recitation “wherein the information is about the product” is indefinite since the product is not even being claimed as part of the invention.

In claim 9, the recitation “wherein the electronic display is not associated with the inherent function of the product” is inaccurate and indefinite since in the body of the claim applicant sets forth the step of “attaching an electronic display to the product” and thus such display is in fact part of the product. Furthermore the information about eh product is clearly “associated” with the inherent function of the product.

In claim 29, the recitation “information comprising label information , product information or source information” is indefinite since the product is not even being claimed as part of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 2 and 5-8, 29, 30 and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Gomersall et al. (4500880).

The disclosure of Gomersall et al. (4500880) teaches the invention as claimed including a label (14) for a product comprising: a) a base (14H) adapted to be fixed to said product, b) an LCD (32) electronic display panel affixed to said base and not associated with the inherent functioning of the product; and c) a programmable circuit (note figure 12) operatively connected to said display panel, said programmable circuit being programmed to output label information to said display panel for display thereon. The preamble recitation of intended use, i.e. “for a product” is considered non-controlling as to the metes and bounds of the claim since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case the label of Gomersall et al. (4500880) clearly has the capability of being adapted to be fixed to a product

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and whether it actually is, or might be, used in such a manner depends upon the performance of a future act of use rather than a structural distinction in the claims.

Claims 1-13 and 16-26, 29-35, 38-55 and 58-64 insofar as definite are rejected under 35 U.S.C. 102(e) as being anticipated by Fitch (5912653).

Fitch (5912653) teaches the invention as claimed including an apparatus having a label (as seen in figure 3) for a product comprising: a) a base (16) adapted to be fixed to said product, b) an LCD (12) electronic display panel affixed to said base and not associated with the inherent functioning of the product; and c) a programmable circuit (see figure 6) operatively connected to said display panel, said programmable circuit being programmed to output label information to said display panel for display thereon. Fitch (5912653) also teaches insofar as definite the method for labeling a product of claims 9-15 including attaching an electronic display to the product, and programming the electronic display to display label information. Note the electronic display is a liquid crystal display with a backlight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 15, 27, 28, 36, 37, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitch (5912653).

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The disclosure of Fitch (5912653)) teaches the invention substantially as claimed as indicated above in the rejection to claim 9. The disclosure of Fitch (5912653) does not set forth a pressure-activated switch or touch screen. The examiner takes Official notice that pressure activated switches and touch screens are typically used in LCDs. It would have been obvious at the time the invention was made to one of ordinary skill in the art to which the invention pertains to provide the LCD of Fitch (5912653) with a pressure activated switch and a touch screen in order to control the display functions of the LCD.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danny Worrell whose telephone number is 703/308-0889. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703/305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DANNY WORRELL
PRIMARY EXAMINER